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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,648	07/23/2002	Jean Kaufmann	FE-19PCT	9225

7590

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EXAMINER

NGUYEN, SON T

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,648

Applicant(s)

KAUFMANN ET AL.

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claim 2 has been cancelled. Pending claims are 1,3-11.

Claim Rejections - 35 USC § 112

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 6, the phrase "< 900" is unclear and believe to be a typographical error.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1,3-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Scherling(US 290803).

For claim 1, Scherling discloses a snaffle bit for horses comprising a mouthpiece A, which can be placed between the upper and lower jaws and extends crosswise through the mouth, the mouthpiece has a through opening (the openings are at each end where the rings go through) at each of its two ends projecting out from the sides of the mouth, each opening carrying a ring (not numbered but shown in the figures), wherein the mouthpiece has the shape of an outward-curved bow extending across the tongue and lower jaw (see fig. 1 for the outward curved shape).

For claim 3, Scherling discloses the bow shape is located on a plane extending approximately perpendicular to the through opening. Note, if one was to draw a plane right under where the label "Fig. 1" is and extend this plane all the way out to where the openings are, the plane would be perpendicular to the openings.

For claim 4, Scherling discloses the mouthpiece consists of several parts e,a,c,d, h,g.

For claim 5, Scherling discloses the mouthpiece comprises two side parts (fig. 1 shows 3 parts, the examiner is considering the first and third (looking from left to right being the left and the right parts) which are connected by a joint (fig. 1, a joint is created at a,c or the whole ref. A, which also includes a,c on each side), wherein the joint can pivot around an axis approximately perpendicular to the plane.

For claim 6, Scherling discloses the joint is located approximately in the center of the mouthpiece (see fig. 1, ref. A,a,c are approximately center).

For claim 7, in an alternative embodiment of the joint as shown in fig. 4, which replaces a,c, Scherling discloses a pin g passes through ends of the side parts, the pin being held in place at an end of the side part containing ref. h, which forms a joint fork (as shown in fig. 4).

For claim 8, Scherling discloses a cross section of the mouthpiece is approximately circular (see all figures, especially fig. 4 for circular mouthpiece).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 9 & 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Scherling (as above) in view of Conrad (US 4587797 on form PTO-1449). For both claims, Conrad teaches a bit comprising a mouthpiece 1 that is made out of steel, which is a non-oxidizing material (col. 3, lines 34-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the mouthpiece of Scherling out of steel as taught by Conrad, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. In re Leshin, 125 USPQ 416.

7. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Scherling (as above) in view of Simington (US 4005564). Scherling is silent about pivot bearing sockets. Simington teaches a bit comprising a mouthpiece 12 having through openings at its ends, the openings include pivot bearing sockets to receive rings 14,16. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ pivot bearing sockets as taught by Simington at the ends of the mouthpiece of Scherling to receive the rings and to allow the rings to be pivoted when connected to a rein.

Response to Arguments

8. Applicant's arguments filed 4/21/03 have been fully considered but they are not persuasive.

Applicants argued that Scherling's bit does not permit gentle treatment of a horse and that it has chain link-like components with protruding projections which lead to injuries on the interior of the mouth. Scherling teaches in lines 10-12, 30-32, that the bit can be used for "soft mouthed" horses since the bit can be reversible so that the projections will not hurt the soft mouthed horse, thus permit gentle treatment. The projections on the bit are for aggressive or hard mouthed horses if one wishes to reverse the bit for more aggressive horses (lines 10-13). In addition, the claim language of the present invention does not indicate anything regarding gentle treatment or without projections; instead, the claim merely claims what is known in the art such as an outwardly curved mouthpiece with through openings connected to rings on each side and the mouthpiece is placed in the mouth of a horse by extending it across the tongue and the lower jaw. Every one of these features are notoriously well known in the art of bridle bit and is clearly taught by Scherling. Since bits are notoriously well known in the art and applicants feel that the distinguishable difference in applicants' bit versus other bits known in the art lies in the fact that applicants' bit is more gentle, then applicants should claim as such and also provide evidence that other bits are not as gentle treatment as that of the present invention. Stating that applicants' bit is more gentle than other bits is a mere allegation without proof that other bits known in the art are defective.

Applicants states that Scherling's mouthpiece is not positionally stable during use and the mouthpiece has sheering points which cause injury to the soft parts of the mouth. As mentioned in the above, applicants' claim language does not

stress on the fact that their mouthpiece is free of obstructions; therefore, arguing to the fact that Scherling's mouthpiece is not stable during use and that the mouthpiece has sheering points is a mere allegation without evidence that Scherling's mouthpiece is defective.

Applicants argued that Scherling does not disclose the curved bow shape of the mouthpiece. Figure 1 of Scherling clearly show a curved bow shaped mouthpiece to accommodate to a horse's mouth. In addition, in lines 30-32, Scherling states that the mouthpiece is curved.

9. Applicants stated in the response filed 4/21/03 that submitted with the response is a brochure of the use of the snaffle bit. However, no such brochure was received or entered into the application.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Son T. Nguyen
Primary Examiner, GAU 3643
July 2, 2003